UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,941	01/15/2002	William Kress Bodin	AUS920010464US1	4426

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INTERNATIONAL CORP (BLF)	LY, ANH
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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/046,941	BODIN ET AL.
	Examiner	Art Unit
	Anh Ly	2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 June 2006</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-18</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-18</u> is/are rejected.

7)☒ Claim(s) <u>2, 5, 8, 11, 14 and 17</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This Office action is response to Applicants' RESPONSE filed on 06/26/2006.

2.   Claims 1-18 are pending in this Application.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4.   Claims 13-18 are rejected under 35 U.S.C. 101 because the preamble and body of claim 13 is a computer program product containing a set of program instructions. It is such as a CD or disk storing program instructions and it is **not executed positively** (not executable or causing) by a machine or a computer containing all physical objects that must be well-defined in the spec. Also, the storage or recording medium such as CD, disk, optical disk and floppy disk must well-defined in the spec. Thus, the CD here is a non-functional descriptive material, a non-statutory subject matter.

5.   The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or act to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal,

does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7.   Claims 1, 7 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The "context" and "shortcut' do not support clearly in the specification. Applicants are advised to amend the claim in a language that supports in the application specification and helps one of ordinary skills in the art to understand the step of invention.

8.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9.   Claims 1, 7 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 1, 7 and 13, the "context" and "shortcut" do not define well in by the claim language that let the examiner does not

understand well the claimed invention: A shortcut is either creating icon shortcut for a

web page or web site or a combination of a sequence of keystroke; and also a context

may be a icon, a window screen or a window application. Applicants are advised to

amend the claim in a language that helps one of ordinary skills in the art to understand

the step of invention.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

11.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

12.   Claims 1, 3-4, 6, 7, 9-10, 12, 13, 15-16 and 18, as the best understanding of

examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent

No.: 6,724,402 B1 issued to Baquero in view of US Patent No. 6,069,628 issued to

Farry et al. (hereinafter Farry).

With respect to claim 1, Baquero teaches a context aware, shortcut enabled

method of presenting information through a user interface on a client device (fig. 3, Start

MENU from a desktop is a context ware and shortcut is items listed on the start menu

from which a selected program is launched quickly without searching the file system:

col. 1, lines 36-65 and col. 4, lines 48-65), the method comprising the steps of:

selecting a context (start menu on a desktop: fig. 3);

inferring from a context definition table, in dependence upon the context, a

context table name and a context field name (start menu on a desktop is having a list or

a table of programs/applications or a table for launching, each program/application has

its own name: fig. 3 and col. 4, lines 48-65 and col. 5, lines 8-12);

selecting information records from an information database in dependence upon

the context, the context table name, the shortcut field name, and the context field name

(fig. 2, for selection of context and shortcut object from start menu shortcuts: col. 1, lines

36-65 and col. 3, lines 18-67 and col. 4, lines 1-6); and

displaying selected records through the user interface on the client device (as a

shortcut icon on the context start menu is selected, the selected program/application is

launched quickly and displayed on the screen of the client machine, that is launching

computer program within a GUI: col. 3, lines 45-55, col. 4, lines 38-42, col. 5, lines 65-

67 and col. 6, lines 1-12, fig. 1).

Baquero teaches a context aware and shortcut and using the shortcut to select

an icon/item in the start menu to launch a computer program/application. Baquero does

not clearly teach receiving a shortcut entered through the user interface, the shortcut

having associated with it a shortcut field name set comprising one or more shortcut field

names.

However, Farry teaches a hot key/shortcut/keystroke table consisting of a

plurality of records and each record contains key representation (shortcut field name)

and name of program/application (fig. 3, item 32b, 34, 36d, col. 4, lines 8-65).

Therefore, it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to combine the teachings of Baquero with the

teachings of Farry. One having ordinary skill in the art would have found it motivated to

utilize the use of hot key table containing one or more key representation for launching

a computer program/application or another action as disclosed (Farry's fig. 3 and col. 4,

lines 8-65), into the system of Baquero for the purpose of using a minimum number of

keystrokes or mouse clicks in a user interface for launching/execution of a plurality of

computer program/application or application programs quickly (Farry's col. 1, lines 15-

18).

With respect to claim 3, Baquero teaches wherein selecting a context further

comprises selecting a default context (start menu on desktop is a default context: col. 1,

lines 45-55).

With respect to claim 4, Baquero teaches wherein selecting a context further

comprises receiving a context from the client device, the context entered by a user

through the user interface (see fig. 3, when start menu on the desktop of a client computer is selected, a list/table of application programs stored on the start menu would be displayed from which a shortcut/icon representing the stored application program enable for a user to select a application program to launch/execute: col. 4, lines 48-65).

With respect to claim 6, Baquero teaches a method as discussed in claim 1.

Baquero teaches a context aware and shortcut and using the shortcut to select an icon/item in the start menu to launch a computer program/application. Baquero does not clearly teach selecting a display form in dependence upon the shortcut value, wherein displaying selected records through the user interface on the client device further comprises downloading the selected records to the client device for display in the display form.

However, Farry teaches transmission the selected structure of a table or records (col. 3, lines 30-45, col. 11, lines 65-67 and col. 12, lines 1-28).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Baquero with the teachings of Farry. One having ordinary skill in the art would have found it motivated to utilize the use of hot key table containing one or more key representation for launching a computer program/application or another action as disclosed (Farry's fig. 3 and col. 4, lines 8-65), into the system of Baquero for the purpose of using a minimum number of keystrokes or mouse clicks in a user interface for launching/execution of a plurality of computer program/application or application programs quickly (Farry's col. 1, lines 15-18).

Claim 7 is essentially the same as claim 1 except that it is directed to a system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 9 is essentially the same as claim 3 except that it is directed to a system rather than a method, and is rejected for the same reason as applied to the claim 3 hereinabove.

Claim 10 is essentially the same as claim 4 except that it is directed to a system rather than a method, and is rejected for the same reason as applied to the claim 4 hereinabove. Claim 12 is essentially the same as claim 6 except that it is directed to a system rather than a method, and is rejected for the same reason as applied to the claim 6 hereinabove.

Claim 13 is essentially the same as claim 1 except that it is directed to a computer program product rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 15 is essentially the same as claim 3 except that it is directed to a computer program product rather than a method, and is rejected for the same reason as applied to the claim 3 hereinabove.

Claim 16 is essentially the same as claim 4 except that it is directed to a computer program product rather than a method, and is rejected for the same reason as applied to the claim 4 hereinabove.

Claim 18 is essentially the same as claim 6 except that it is directed to a

computer program product rather than a method, and is rejected for the same reason as

applied to the claim 6 hereinabove.

Allowable Subject Matter

13.   Claims 2, 5, 8, 11, 14 and 17 are objected to as being dependent upon a rejected

base claim, but would be allowable if rewritten in independent form including all of the

limitations of the base claim and any intervening claims. "wherein selecting records

further comprises creating a query, wherein the query includes: the context table name

as a table for the query, the shortcut field names as field names for the query; the

context and the context field name in a condition for the query and wherein the context

has an initial context value, and the method comprises the further steps of: assigning, in

response to user input through the user interface, a new context value to the context;

and   repeating, in response to user input from the user interface, the steps of assigning

a new context value to the context, inferring a context table name and a context field

name, selecting records, and downloading selected records." And it would be allowable

if overcoming the 101 rejections above.

Contact Information

14.   Any inquiry concerning this communication or earlier communications from the

examiner should directed to ANH LY, whose telephone number is (571) 272-4039 or via

e-mail: ANH.LY@USPTO.GOV **(written authorization being given by Applicant(s) -**

MPEP 502.03 [R-2]) or fax to (571) 273-4039 (examiner's personal fax number).

The examiner can normally be reached on TUESDAY – THURSDAY from 8:30

AM – 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, **John Breene,** can be reached on **(571) 272-4107.**

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed

to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to:

Central Fax Center: (571) 273-8300

ANH LY
JAN. 9th, 2007

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